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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,242	05/23/2005	Georg Gros	DNAG-291 (10412293)	9240
24972 7590 06/19/2008 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			EXAMINER VIJAYAKUMAR, KALLAMBELLA M	
			ART UNIT 1793	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/511,242	Applicant(s) GROS ET AL.	
	Examiner KALLAMBELLA VIJAYAKUMAR	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-35, 37-63 and 65-70 is/are rejected.
- 7) ☒ Claim(s) 36, 47, 50, 64, 69 and 70 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/27/2008; 12/09/2004; 10/13/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This application is a 371 of PCT/EP03/04057 filed 04/17/2003. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
- The preliminary amendment filed 05/23/2005 has been entered. Claims 31-70 are currently pending with the application.
- The information disclosure statement (IDS) submitted on 05/27/2008, 12/09/2004, and 10/13/2004 are in compliance with the provisions of 37 CFR 1.97, and the examiner has considered them.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

- Claims 47, 50 and 69-70 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 47 with a range of 0-75 wt% for substance C makes the component optional and does not further limit the positive presence of the component in claim-31.

Claim 50 does not further limit the at least one substance A with a Mohs hardness of at least 5.5 in claim-31.

Claims 69-70 do not further limit the specific solvents and binder in claim 31.

Claim 64 is objected to because of the following informalities: It depends upon a cancelled claim -5. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 50 and 69-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “aluminum, iron, cobalt, copper, molybdenum, nickel, niobium, silver, tantalum, titanium, vanadium, tungsten, zinc, tin, aluminum-, iron-, cobalt-, copper-, molybdenum-, nickel-, niobium-, silver-, tantalum-, titanium-, vanadium-, tungsten-, zinc-, and tin-containing alloys” in claim 50 is used to mean “hard particles having a Mohs hardness of at least 5.5”, while they are metals and their alloys that do not meet instant claimed property in claim-31. Also, it appears that a comma is missing in line 2 before ‘borides’.

Claims 69 and 70 recite the limitation of an electrically conductive coating comprising the composition of a claim-31 and a solvent; and a vehicle comprising a coating according to claim-69 respectively, wherein the a conductive coating is formed upon coating the liquid composition and drying it, whereby solvent and/or solvent-vehicle can not exist in the coating.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

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at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 31-35, 37-41, 43-64, and 66-70 are rejected under 35 U.S.C. 103(a) as obvious over Wiechelhaus et al (WO 99/24545).

The US patent 6,479,103 issued to Wiechelhaus et al is being used as the English Translation of the WO Document.

Wiechelhaus et al teach the composition of a corrosion resistant coating composition comprising 10 to 40 wt. % of an organic binder; 0 to 15 wt.% of a silicate-based anti-corrosive pigment <component-D>, 40 to 70 wt.% of powdered extenders that include zinc, aluminum, carbon black <component C>, graphite and/or molybdenum disulfide <component-B>, iron phosphide <component-A>, SnO/Sb₂O₃ doped-BaSO₄ <component-B/A>, 0 to 30 wt.% of a solvent, and the organic binder consists of at least one epoxy, at least one curing agent selected from guanidine, substituted guanidines, substituted ureas, cyclic tertiary amines and mixtures thereof, together with at least one blocked polyurethane resin <post cross-linking agent>. The amine curing agents further meet the limitation of corrosion inhibitor that is not in particulate form (Abstract; Cl-3, Ln 1-29; Cl-5, Ln 49-64; Tables 1-3; Cl-6, Ln 34). The specific

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examples in Table-1 teach the addition of a mixture of pigments/conductive agents, phthalocyanine <corrosion inhibitor which is not in particle form> and modified castor oil <additive> <Tbl-1>. The prior art further teaches an example containing Zn, MoS₂, doped silica and phthalocyanine <Tbl-3, Comparative>. The steel sheet metal was cleaned, optionally chromated <precoated> and then coated with 2-5 micron coating, whereby the particles present in the coating are necessarily less than 2 micron in diameter for a monolayer film over a surface with a 2-micron thick coating, that meets the limitation of particle sizes in the claims.

The prior art fails to teach a composition containing the pigments in the ratio of $\Sigma(B+C)$ wrt $\Sigma(A+B+C)$ being 0.25-99.5 wt% per claim-31 and pigments ratio of $\Sigma(A+B+C)$ wrt $\Sigma(A+B+C+D)$ being 30-99.0 wt% per claim-32 and the component ratio per claim-46.

However, the prior art teaches the addition of a blend of pigments and addition of even miniscule amount of iron phosphide in examples 1 and 3, or MOS₂ in examples 9 and 10 <Tbl-1> will put the pigment ratios close to the instant claimed ranges, and it would have been obvious to a person of ordinary skilled in the art to do so, because they are corrosion protection pigments and the composition has the same common utility with instant claimed composition as corrosion-resistant conductive coatings for metals (Spec, US 2006/0058423; P-0001) in obviously arriving at instant composition, and Similarly, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties.

Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium" as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.). The component pigment ratios further meet the ratio limitation in claims 46-47 and composition/coating in claims 69-70.

With regard to claims 33-35, 37-39, 40-41, 43-45, 48-49, the prior art teaches a coating of with 2-5 micron coating, whereby the particles present in the coating are necessarily less than 2 micron in diameter for a monolayer film over a surface with a 2-micron thick coating, and the instant claimed particle sizes would be obvious. With regard to claim-45, the particle size of the particles vary from sub-micron to

the thickness of the film (for a monomolecular film) and the particle size ratio between particles A and C would overlap with the instant claimed ratio of 0.1-4 (for equi-sized particles, the ratio would be 1.0) and In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

With regard to claims 50 and 52, the prior art teaches adding iron phosphide <component-A> in the composition that is 100% of component –A and meets the limitation of at least 30% of A being iron phosphide in claim-52.

With regard to claim 51, the prior art teaches adding carbon black.

With regard to claim 53, the prior art teaches adding graphite and molybdenum disulfide.

With regard to claims 54-55, the range of not more than 0.5 wt% in claim-54 includes $0 \leq x \leq 0.5$ and the range of not more than 0.5 wt% in claim-55 includes $0 \leq x \leq 0.5$; makes the component optional and Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure [MPEP 2111.04 [R-3]].

With regard to claim 56, the prior art does not add wax or wax-like substance.

With regard to process claims 57-63 and 65-68, the prior art further teaches making the coating composition by mixing the components till homogeneous (CI-6, Ln 25-33). The composition was applied over a steel sheet metal that was cleaned, optionally chromated <precoated> and then coated with 2-5 micron coating, and drying the coating at a peak metal temperature of 180-235C (CI-6, Ln 9-17). With regard to the process steps in claims 60-63, the examiner asserts that the prior art coating will be either same or substantially same as that produced by the claimed process steps.

2. Claims 31-35, 37-41, 43-64, and 66-7 are rejected under 35 U.S.C. 103(a) as obvious over Wiechelhaus et al (US 6,479,103).

Wiechelhaus et al teach the composition of a corrosion resistant coating composition comprising 10 to 40 wt. % of an organic binder; 0 to 15 wt.% of a silicate-based anti-corrosive pigment <component-D>, 40 to 70 wt.% of powdered extenders that include zinc, aluminum, carbon black <component C>, graphite and/or molybdenum disulfide <component-B>, iron phosphide <component-A>, SnO/Sb₂O₃ doped-BaSO₄ <component-B/A>, 0 to 30 wt.% of a solvent, and the organic binder consists of at least one epoxy, at least one curing agent selected from guanidine, substituted guanidines, substituted ureas, cyclic tertiary amines and mixtures thereof, together with at least one blocked polyurethane resin <post cross-linking agent>. The amine curing agents further meet the limitation of corrosion inhibitor that is not in particulate form (Abstract; Cl-3, Ln 1-29; Cl-5, Ln 49-64; Tables 1-3; Cl-6, Ln 34). The specific examples in Table-1 teach the addition of a mixture of pigments/conductive agents, phthalocyanine <corrosion inhibitor which is not in particle form> and modified castor oil <additive> <Tbl-1>. The prior art further teaches an example containing Zn, MoS₂, doped silica and phthalocyanine <Tbl-3, Comparative>. The steel sheet metal was cleaned, optionally chromated <precoated> and then coated with 2-5 micron coating, whereby the particles present in the coating are necessarily less than 2 micron in diameter for a monolayer film over a surface with a 2-micron thick coating, that meets the limitation of particle sizes in the claims.

The prior art fails to teach a composition containing the pigments in the ratio of $\Sigma(B+C)$ wrt $\Sigma(A+B+C)$ being 0.25-99.5 wt% per claim-31 and pigments ratio of $\Sigma(A+B+C)$ wrt $\Sigma(A+B+C+D)$ being 30-99.0 wt% per claim-32 and the component ratio per claim-46.

However, the prior art teaches the addition of a blend of pigments and addition of even miniscule amount of iron phosphide in examples 1 and 3, or MOS₂ in examples 9 and 10 <Tbl-1> will put the pigment ratios close to the instant claimed ranges, and it would have been obvious to a person of ordinary skilled in the art to do so, because they are corrosion protection pigments and the composition has the same common utility with instant claimed composition as corrosion-resistant conductive coatings for metals (Spec, US 2006/0058423; P-0001) in obviously arriving at instant composition, and Similarly, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties.

Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium" as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.). The component pigment ratios further meet the ratio limitation in claims 46-47 and composition/coating in claims 69-70.

With regard to claims 33-35, 37-39, 40-41, 43-45, 48-49, the prior art teaches a coating of with 2-5 micron coating, whereby the particles present in the coating are necessarily less than 2 micron in diameter for a monolayer film over a surface with a 2-micron thick coating, and the instant claimed particle sizes would be obvious. With regard to claim-45, the particle size of the particles vary from sub-micron to the thickness of the film (for a monomolecular film) and the particle size ratio between particles A and C would overlap with the instant claimed ratio of 0.1-4 (for equi-sized particles, the ratio would be 1.0) and In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

With regard to claims 50 and 52, the prior art teaches adding iron phosphide <component-A> in the composition that is 100% of component –A and meets the limitation of at least 30% of A being iron phosphide in claim-52.

With regard to claim 51, the prior art teaches adding carbon black.

With regard to claim 53, the prior art teaches adding graphite and molybdenum disulfide.

With regard to claims 54-55, the range of not more than 0.5 wt% in claim-54 includes $0 \leq x \leq 0.5$ and the range of not more than 0.5 wt% in claim-55 includes $0 \leq x \leq 0.5$; makes the component optional and Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure [MPEP 2111.04 [R-3]].

With regard to claim 56, the prior art does not add wax or wax-like substance.

With regard to process claims 57-63 and 65-68, and the prior art further teaches making the coating composition by mixing the components till homogeneous (Cl-6, Ln 25-33). The composition was

applied over a steel sheet metal that was cleaned, optionally chromated <precoated> and then coated with 2-5 micron coating, and drying the coating at a peak metal temperature of 180-235C (CI-6, Ln 9-17). With regard to the process steps in claims 60-63, the examiner asserts that the prior art coating will be either same or substantially same as that produced by the claimed process steps.

3. Claims 31-35, 37-50, 53-63 and 65-68 rejected under 35 U.S.C. 103(a) as being unpatentable over Soltwedel (US 6,008,462).

Soltwedel teaches a mar resistant corrosion inhibiting weldable coating for metals and a coating composition comprising: conductive metallic particles such as Fe <component-C> with a particle size passing through -325 mesh (< 45 micron) in an amount of up to 50 wt% and preferably 30-40 wt% (CI-9, Ln 34-60); and inorganic fillers such as oxides <component-A> in an amount of not greater than 25 wt%, and preferably ~10-20 wt% (CI-10, Ln 60-CI-11, Ln 13); an internal lubricant such as MoS₂ <component-B> wherein the lubricant had a particle size of 0.01-30 micron and present in an amount of 0.2-1.5 wt% total solids (CI-7, Ln 40-49); corrosion inhibitors such as strontium chromate <component-D> in an amount between ~3 and 10 wt% and with a particle size of 2-6 micron (CI-11, Ln 34- 47); suspension agent such as magnesium aluminum silicate in an amount of 0.3-2 wt% <component-D> (CI-10, Ln 15-15); organic binders such epoxy (CI-4, Ln 22-41; CI-6, Ln 46-66) crosslinker, solvent, catalysts such as tertiary amines <corrosion inhibitor which is not in particulate form> (CI-8, Ln 33), (Abstract, CI-4, Ln 22-41; CI-7, Ln 11-17; CI-8, Ln 25-30; CI-9, Ln 35-59; CI-10, Ln 38-40, Ln 60-67; CI 37-13-14, Table-1). The weldable coating was about 0.4-0.6 mil (10-15 micron) and a particle size of less than 10 micron for the oxides (component-A) would be obvious (CI-13, Ln 9-15).

The prior art is silent about the exact particle size distribution of Iron particles.

However, the prior teaches the iron particles to have a size less than -325 sieve (44 micron) that encompasses the range from sub micron to 45 micron, and teaches a film with a thickness of 10-15 micron whereby the presence of Fe particles will less than 10 micron size would be obvious. The pigments in the ratio of $\Sigma(B+C)$ wrt $\Sigma(A+B+C)$ being 0.25-99.5 wt% per claim-31 and pigments ratio of $\Sigma(A+B+C)$ wrt $\Sigma(A+B+C+D)$ being 30-99.0 wt% per claim-32 would over lap with the prior art component

ratios, and In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). This would further meet the ratio of pigments in claim-46. This will meet the composition/coating in claims 69-70.

With regard to claims 33-35, 37-39, 40-41, 43-44, and 48-49, the prior art teaches a component particle sizes overlap with the instant claimed ranges, and In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990)

With regard to claims -42 and 45, the particle size of the respective prior art components overlap with the instant claimed components and the particle size ratios of the components when calculated as their ratios would obviously overlap with the instant claimed ranges for particle sizes and In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

With regard to claim 50, the prior art teaches adding oxides <component-A>

With regard to claim 53, the prior art teaches adding molybdenum disulfide.

With regard to claims 54-56, the range of not more than 0.5 wt% in claim-54 includes $0 \leq x \leq 0.5$ and the range of not more than 0.5 wt% in claim-55 includes $0 \leq x \leq 0.5$; makes the component optional and Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure [MPEP 2111.04 [R-3]]. With regard to claim-56, the prior art does not add any waxy material (See Ex-1; CI 13-14).

With regard to process claims 57-63 and 65-68, the prior art further teaches making the coating composition by mixing the components till homogeneous (CI-12, Ln 36-42). The composition was applied over a steel sheet metal <direct coating> or galvanized steel <precoated> and then coated with 2-5 micron coating, and drying the coating at a peak metal temperature of 180-235C (CI-12, Ln 44 – CI-13, Ln

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15). With regard to the process steps in claims 60-63, the examiner asserts that the prior art coating will be either same or substantially same as that produced by the claimed process steps.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31-35, 38, 40, 46, 47, 50, 56, 69-70 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of 104-108, 112, 116, 134 and 136 copending Application No. 10/5112223. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and copending application are drawn to similar compositions having similar components and same utility as conductive coatings, while copending claims contain specific ranges of components and differ from the instant claims that do not have the same ranges, and it would be obvious to a person of ordinary skilled in the art to optimize the composition for coating applications because they are well known in the art (See Wiechelhaus et al (WO 99/24545)).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record neither teaches nor fairly suggestive of a composition containing the pigments in Applicants the ratio of $\Sigma(A+B+C)$ wrt $\Sigma(A+B+C+D)$ of 30 wt%, wherein the pigment-D is present in the amount of 70 wt%.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KALLAMBELLA VIJAYAKUMAR whose telephone number is (571)272-1324. The examiner can normally be reached on M-F 07-3.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 5712721358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KMV/
June 06, 2008.

/Stuart Hendrickson/
Primary Examiner, Art Unit 1793